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EXAMINER

MOHANDESI, JILA M

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,933

Applicant(s)

SCHMID, RAINER K.

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8-15 and 17-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8-15 and 17-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

DECLARATION UNDER 35 CFR § 1.132

1. Applicant's Declaration under CFR § 1.132 filed on July 01, 2003 has been fully considered and is persuasive. Therefore, the rejection of claims 1-12 and 14-32 under 35 U.S.C. § 103(a) as being unpatentable over Jacinto '153 has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of different interpretation of previously submitted reference Horibata (4,457,084) and Cox (3,739,500) and newly found reference Miceli (1,516,395).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5-6, 8-15 and 17-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claims the phrase "rigid plates" is inaccurate, vague and indefinite. Rigid means fixed, not moving. Rigid is defined in American Heritage Dictionary of English Language, Third Edition, items 1 and 2 under the word "rigid" as being **not flexible** or pliant; **stiff; not moving; fixed**. However, in Figures 8A-8C of the instant application, the rigid plates are clearly shown to move, flex and bend. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so

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redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “rigid” in all the claims is used by the claim to mean “flex, bend, move”, while the accepted meaning is “not flexible, fixed and not moving.” The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 5 - 6, 8, 12, 17 - 33, 35, 36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Horibata et al. (4,457,084). Horibata '084 discloses an article of footwear comprising: an upper (1); an outsole (base 3) defining a ground engaging surface; a sole disposed between said upper and said outsole, said sole including an energy return system; wherein said energy return system comprises a first rigid plate, a second rigid plate (See column 3, lines 20-27) spaced a predetermined distance from said first rigid plate, at least one elastomeric separating element (coil springs 2) disposed there between to maintain the spacing between said plates, the separating element allowing independent movement of the first and second rigid plates with respect to one another in multiple dimensions including medial lateral movement and vertical movement.

Inasmuch as applicant has defined its plates to be rigid, and rigid being a relative term, the plates of Horibata `084 which are used for the protection of the molded surfaces are also considered to be rigid compared to the sponge material (87) held there between the two plates.

With respect to claim 6, note the arcuate separating elements (spring coils 2) in Figure 1 embodiment.

With respect to claims 5, 17, 21, 22, 23, 25, 26, 27, 29, 30 and 31, note the two separating elements (spring coils 2) in Figure 1 embodiment which allow the first and second plates to move independently of one another in all dimensions.

6. Claims 8, 14-15, 18, 19 and 36-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox (3,739,500). Cox `500 discloses an energy return system for use in a shoe sole, said system comprising: a first rigid plate (bottom 14); a second rigid plate (sole 17) spaced a predetermined distance from said first rigid plate; at least one elastomeric separating element (elevating extension 16, see column 2, lines 48-50), maintaining the distance between said first and second rigid plates, the separating element allowing independent movement of the first and second rigid plates with respect to one another in multiple dimensions including medial lateral movement and vertical movement. See Figures 1-13 embodiments.

Inasmuch as applicant has defined its plates to be rigid, and rigid being a relative term, the plates of Cox `500 are also considered to be rigid compared to the foam material held there between the two plates.

7. Claims 8, 17, 18, 19, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Miceli (1,516,395). Miceli `395 discloses an energy return system for use in a shoe sole, said system comprising: a first rigid plate (plate 1); a second rigid plate (plate 2) spherical connecting pieces 3, see column 2, lines 1-3), maintaining the distance between said first and second rigid plates, the separating element allowing independent movement of the first and second rigid plates with respect to one another in multiple dimensions including medial lateral movement and vertical movement. See Figure 2 embodiment.

Inasmuch as applicant has defined its plates to be rigid, and rigid being a relative term, the plates of Miceli `395 are also considered to be rigid compared to the flexible material held there between the two plates.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-3, 9 -11, 13-15, 34, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horibata `084 in view of Schmid (4,858,338). Horibata `084 as described above discloses all the limitations of the claims except for the specifics of the material of the rigid plates. Schmid `338 discloses an insert/sole (20) for an article of footwear where the insert/sole absorbs, stores and returns the kinetic energy of a wearer to the wearer's foot. The insert/sole (20) is made of an elastic material which is

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defined as a high tensile strength material which has a modulus of elasticity of at least 32X10 lb/in made of a plurality of Graphite fibers. Graphite fibers have the advantages that they have a high tensile strength, a high modulus of elasticity, are lightweight, and can be easily processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rigid plates of Horibata '084 from plurality of Graphite fibers as taught by Schmid '338 to enhance the energy return properties of the energy return system. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 13, the insert/sole of Schmid '338 discloses a rocker bottom (28) to cradle the first metatarsal head of the foot of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a rocker bottom to the first and second rigid plates of Horibata '084 as taught by Schmid '338 to better cradle the foot of the wearer.

With respect to claims 14, 15, 34, 37 and 39 and the size of the plates, it would have been an obvious matter of design choice to modify the size of the plates, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

10. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox '500 in view of Schmid (4,858,338). Cox '500 as described above discloses all the limitations of the claims except for the specifics of the material of the rigid plates.

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Schmid `338 discloses an insert/sole (20) for a an article of footwear where the insert/sole absorbs, stores and returns the kinetic energy of a wearer to the wearer's foot. The insert/sole (20) is made of an elastic material which is defined as a high tensile strength material which has a modulus of elasticity of at least 32×10^6 lb/in made of a plurality of Graphite fibers. Graphite fibers have the advantages that they have a high tensile strength, a high modulus of elasticity, are lightweight, and can be easily processed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the rigid plates of Cox `500 from plurality of Graphite fibers as taught by Schmid `338 to enhance the energy return properties of the energy return system. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

11. Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miceli `395 in view of Schmid (4,858,338). Miceli `395 as described above discloses all the limitations of the claims except for the specifics of the material of the rigid plates. Schmid `338 discloses an insert/sole (20) for a an article of footwear where the insert/sole absorbs, stores and returns the kinetic energy of a wearer to the wearer's foot. The insert/sole (20) is made of an elastic material which is defined as a high tensile strength material which has a modulus of elasticity of at least 32×10^6 lb/in made of a plurality of Graphite fibers. Graphite fibers have the advantages that they have a high tensile strength, a high modulus of elasticity, are lightweight, and can be easily processed. Therefore, it would have been obvious to one of ordinary skill in the art at

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the time the invention was made to make the rigid plates of Miceli `395 from plurality of Graphite fibers as taught by Schmid `338 to enhance the energy return properties of the energy return system. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

With respect to claim 13, the insert/sole of Schmid ` 338 discloses a rocker bottom (28) to cradle the first metatarsal head of the foot of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a rocker bottom to the first and second rigid plates of Miceli `395 as taught by Schmid `338 to better cradle the foot of the wearer.

Response to Arguments

12. Applicant's arguments with respect to claims 1-3, 5-6, 8-15 and 17-39 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

**JILA M. MOHANDESI
PRIMARY EXAMINER**



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
September 04, 2003